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No. 95-1900

IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

EXXON CHEMICAL PATENTS, INC.,
EXXON CORPORATION, AND
EXXON RESEARCH AND ENGINEERING CO.,
Petitioner,

v.

LUBRIZOL CORPORATION,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

MOTION FOR LEAVE TO FILE BRIEF AND BRIEF SUPPORTING PETITIONER ON BEHALF OF PFIZER INC. AS *AMICUS CURIAE*

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MOTION FOR LEAVE TO FILE BRIEF SUPPORTING PETITIONER ON BEHALF OF PFIZER INC. AS *AMICUS CURIAE*

Pfizer Inc. ("Pfizer") respectfully moves this Court, pursuant to Rule 37.2(b) of the Rules of the Supreme Court, for leave to file the attached brief as *amicus curiae* in the above-captioned case. Pfizer's brief is in support of the Petitioner, and urges that this Court review and reverse the decision below.

Counsel for Petitioner, Exxon Chemical Patents, Inc., et al. ("Exxon"), have consented in writing to the filing of an *amicus* brief by Pfizer. No consent of the Respondent,

Lubrizol Corporation ("Lubrizol") could be obtained, thereby necessitating this motion.

The subject Petition of Exxon addresses a decision by the Court of Appeals for the Federal Circuit ("Federal Circuit") which held that a claim to a chemical formulation composition cannot be infringed if there is any interaction between any of the ingredients after they are added to the composition, such that any ingredient changes in chemical form or ratio from that listed in the claim. The effect of the decision below goes far beyond the interpretation of the patent in suit. The decision below has rendered composition claims which are defined by listing the ingredients to be mixed together highly suspect and possibly unenforceable against infringers. Pfizer believes that the decision is erroneous, contrary to law, and contrary to established chemical patent drafting procedures. The decision has a major negative impact on the interpretation of thousands of chemical patents drafted in the same manner as Exxon's patent, and will lead to significant confusion regarding the drafting and interpretation of such claims in the future.

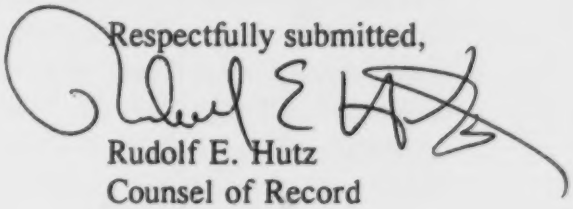
Pfizer has been engaged for years in research, development and sale of medical drugs designed to alleviate and cure various conditions destructive of the health of mankind. Pfizer possesses a unique historical perspective as an innovator and marketer of medical drugs and other chemical products. Pfizer has obtained and holds numerous patents directed to pharmaceutical and chemical compositions. Given its extensive experience in drafting, obtaining, and reviewing patents to pharmaceutical and chemical compositions, as well as its extensive history in those fields, Pfizer believes its Brief will assist this Court to understand the significant negative effect of the Federal Circuit's decision below upon the pharmaceutical and chemical industry as a whole.

As shown in the attached Brief, the issue decided by the Federal Circuit affects far more than the individual interests of the named parties. The decision below, which holds that a claim written in a form in accordance with long accepted and understood chemical practice is now limited by requiring proof that the ingredients listed in the claims retain their identity once mixed to create the claimed composition, adversely impacts on innovation in the pharmaceutical and chemical industry, the drafting of chemical composition patents in the future, and the value of the thousands of chemical composition patents written in the same form, all to the detriment of the public interest. Patents directed to a wide variety of important chemical inventions, including lifesaving and quality of life-enhancing drugs, are now, if the decision below stands, possibly relegated to an effectively unenforceable status.

The rights possessed by owners of chemical composition patents cannot and should not be taken away under the guise of *de novo* patent claim construction without regard for the reality of basic chemistry, the long-standing and accepted practice of drafting and interpreting chemical composition claims, and the existing statutory requirements on the issue.

Pfizer respectfully requests that the Court permit it to file the attached brief and that Petitioner's request to issue a writ of certiorari to review the judgment and opinion of the Federal Circuit be granted.

Respectfully submitted,



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INTEREST OF *AMICUS*

Pfizer Inc. ("Pfizer") is a research-based innovator and manufacturer of pharmaceutical compositions and other chemical formulations. For many years, Pfizer has conducted research and development into such products for which it has been rewarded with hundreds of United States Patents.

As an innovator and seller of new drugs and other important chemical products, Pfizer is thoroughly familiar with the procedures for obtaining patent protection in the United States and throughout the world. Pfizer has actively participated in obtaining patents to pharmaceutical and other chemical inventions, including compositions, before the United States Patent and Trademark Office ("PTO"), and has reviewed and interpreted similar patents to others since well before the Federal Circuit's recent decision at issue here. As a substantial patent owner, Pfizer recognizes the incentives offered by the United States patent system in return for research expenditures and innovation to cure and alleviate conditions destructive to the well being of humanity.

The decision below directly affects far more than the named parties and the particular patent at issue, and it has a significant impact considerably beyond the facts of that decision. Chemical inventions have supported some of the most important advances in the health, safety and comfort of mankind. Over the last one hundred years alone, chemistry has impacted and improved essentially every aspect of life in these United States. Enormous amounts of research dollars have been spent by innovative companies like Pfizer to discover, develop and market a wide variety of chemical products.

Frequently, innovation in the chemical field leads to novel combinations of individual chemicals, all mixed together

in particular amounts to make so-called chemical compositions. Until the decision below, these important inventions typically were protected by patent claims that simply identified the individual ingredients and their amounts used to make up the composition. This is how Exxon claimed its lubricant composition, by listing the ingredients and amounts which went into that composition. This was how chemists, inventors, patent attorneys, patent examiners and judges historically understood chemical compositions should be claimed.

By deciding that such a patent claim to a chemical composition cannot be infringed if there is some interaction between the ingredients after they have been mixed to form the composition, such that any ingredient changes in chemical form or ratio from that listed in the claim, the Federal Circuit has rendered patents claiming chemical compositions highly suspect and possibly unenforceable. Patents directed to a wide variety of lifesaving and quality of life-enhancing drugs, as well as other significant chemical compositions, may be effectively avoided, thereby reducing the reward and hence the incentive to undertake the immense expense needed to develop and market new products. Moreover, if it stands, the decision below will generate significant confusion regarding the drafting and interpretation of such patent claims in the future, and will provide copyists with the opportunity to escape their piracy to the detriment of the innovator.

Pfizer believes that the full scope of patents to chemical compositions should be restored by this Court. Given the Federal Circuit's exclusive jurisdiction (28 U.S.C. § 1295), no other judicial forum is available to achieve this objective.

SUMMARY OF THE ARGUMENT

Exxon's Petition for Certiorari should be granted because the decision below is contrary to established law. The court below found that the patent owner had not proven infringement because although the accused infringer initially used the same ingredients in the same amounts as claimed, some of those ingredients interacted after mixing and the patentee had not demonstrated that after interaction the amounts of specified ingredients were as claimed. In so doing, the decision ignored consistent and longstanding practice regarding the drafting and interpretation of chemical composition claims. And the decision may be applied retroactively to deprive innovators of valuable patent rights because they drafted claims in reliance on historical precedent. The decision also ignores the realities of chemical interactions, and it significantly impedes the enforceability of future and existing chemical patents.

ARGUMENT

I. The Decision Below Introduces Unnecessary Complexity Into Chemical Claim Drafting And Serves No Statutory Or Practical Purpose.

The Federal Circuit's interpretation of chemical composition claims, which requires the patentee to present evidence that the ingredients listed in the claims retain their identity once mixed to create the claimed composition, adds a new requirement to the drafting, interpretation and enforceability of chemical composition patents that is not required by logic or the Patent Laws. Congress, in exercising the power granted to it under Article I, § 8, Cl. 8 of the Constitution, enacted Title 35 of the United States Code to provide uniform statutory requirements governing the grant and enforcement of patents in the United States. Those laws expressly permit patent protection for "compositions of matter." 35 U.S.C. § 101.

The Patent Laws also set forth certain statutory requirements regarding the drafting of proper patent claims in exchange for the grant of patent protection. A patentee must include one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. 35 U.S.C. § 112, ¶ 2. Moreover, an applicant must also provide a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the claimed invention. Thus, all an applicant must do to satisfy the statutory requirements of Title 35 is to describe his invention in a clear and unambiguous manner so that those skilled in the art can easily understand what is disclosed and the scope of what is claimed.

The Patent Laws do not require a patentee to understand the scientific principles behind how or why an invention works. *See Newman v. Quigg*, 877 F.2d 1575, 1581 (Fed. Cir. 1989) (observing that "it is not a requirement of patentability that an inventor correctly set forth, or even know, how or why the invention works"); *Fromson v. Advanced Offset Plate, Inc.*, 720 F.2d 1565, 1570 (Fed. Cir. 1983) ("[I]t is axiomatic that an inventor need not comprehend the scientific principles on which the practical effectiveness of his invention rests"). Nor do the Patent Laws require an inventor to detail every possible chemical or physical reaction or interaction which might occur in a claimed chemical composition. Congress clearly recognized the difficulties inherent in a complex field where countless variables can have a profound effect on the end product. Moreover, many of these variables are not susceptible to exact measurement but rather are approximations, hypotheses, and theories. As a result, under the Patent Laws and accepted practice as they existed before the decision below, whatever interactions occurred after mixing the components of a composition were irrelevant to the specificity and clarity of the claim and its understanding by persons in the relevant field.

The decision below now requires inventors and patentees to recite in their claims all of the possible interactions or reactions (including hypothetical and potentially unknown ones), failing which they may be penalized through the inability to enforce their patents against infringers who start with the exact same ingredients in the exact same proportions. Thus, through its *de novo* review of the district court's claim interpretation, the Federal Circuit's own interpretation (which itself was not argued by either party or supported by the record below) has engrafted a new requirement on patents to chemical compositions, a requirement contrary to the existing Patent Laws.

II. The Decision Below Ignores Long Understood Claim Drafting Practice And The Realities Of Chemistry.

The decision below is contrary to long standing practice regarding the drafting and interpretation of chemical composition claims, as well as the realities of chemical interactions. The patent bar and the PTO have long recognized that describing and claiming a chemical composition by listing its ingredients and, where necessary, their amounts is an entirely acceptable method of claim drafting. Indeed, multiple authorities recognize that a composition of matter is formed by mixing separate ingredients, and that those ingredients frequently lose their separate identities when combined in the resulting composition, 1 W. Robinson, The Law of Patents for Useful Inventions § 192, p. 278 (1890); 1 D. Chisum, Patents § 1.02[2], p. 1-10 (1995) (quoting Robinson); E. Lipscomb, Walker on Patents § 11.8, at pp. 328-29 (1985) (quoting Robinson). Nonetheless, it was deemed entirely proper to claim such inventions simply by listing the ingredients and their proportions. The resulting claims protected the composition whether or not some interactions occurred. R. Farber, Landis on Mechanics of Patent Claim Drafting § 49, p. 148 (1990).

As pointed out by Judge Newman in her dissent from the Federal Circuit's refusal to rehear the decision below, claims written in this fashion are easy to describe, easy for the PTO to search and examine for patentability, easy to understand, and (until now) unambiguous in content and scope. Moreover, even if interaction among the ingredients occurs after they are mixed together, this does not affect the specificity of the description of what has been invented. It is not necessary to know what physical or chemical interactions occur in order to describe the invention, which resides in the combination of the listed ingredients. *See Exxon Chemical*

Patents, Inc. v. Lubrizol Corp., 77 F.3d 450, 453 (Fed. Cir. 1996). This view is entirely consistent with how those who practice in the chemical arts prepare, read and understand claims written in this fashion. This was precisely how the claims of the patent in suit were written. The Federal Circuit, however, rejected this long standing and recognized interpretation in favor of its own interpretation, unilaterally adopted by a divided court. This decision is contrary to long standing and accepted practice.

The Federal Circuit's requirement that patentees who use such claims to describe their invention must supply proof that the ingredients exist in the accused product "at some time after its creation" (*Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1560 (Fed. Cir. 1995)) also ignores the realities of chemistry. All chemicals when mixed together interact to some degree. Those interactions are dependent upon numerous variables such as those described in Judge Newman's dissent (77 F.3d at 455). Given these variables, it is frequently difficult, if not impossible, to determine accurately how and when those reactions occur, particularly in highly complex chemical compositions. The Patent Laws recognized this inherent difficulty by permitting chemical composition claims to be written by describing their ingredients and yet providing protection to compositions where chemical changes may have occurred subsequently. Congress clearly did not want to impede the progress of science and useful arts by requiring patentees to know exactly how or why their inventions worked. Nevertheless, the decision below imposes just such a requirement with the penalty for non-compliance being a patent which cannot be enforced effectively against infringers.

III. The Decision Below Has Enormous Potential Adverse Impact On Existing Chemical Patents.

The decision below does not merely impact future patent practice. It also has a significantly negative impact on the thousands of existing patents already issued which utilize the same long standing and recognized method of claiming chemical compositions, a method which was well understood by those practicing in the chemical field. Indeed, many of those patents were written at a time when there were no tests available to identify or measure accurately the numerous reactions or interactions which may occur once the ingredients to the claimed composition were mixed. The inventors knew the ingredients "going in", they knew the resulting composition was highly beneficial -- even life saving -- and they could reproduce the result, at will, simply by mixing the same ingredients in the same amounts, each time.

Yet, the decision below now adds a retroactive requirement, which is unnecessary and in all likelihood cannot be satisfied by those patentees. Owners of those patents must now present evidence regarding infringement based on what might or might not actually occur once the ingredients are mixed together. As a result, those patents have been seriously compromised, and perhaps effectively rendered unenforceable because an accused infringer can now argue that any type of reaction or interaction (including those not easily susceptible of proof) avoids infringement even when the exact same ingredients in the exact same proportions are initially mixed. Thus, the Federal Circuit's interpretation below has an adverse impact far beyond the interpretation of the precise patent in suit.

CONCLUSION

The decision of the Federal Circuit below is a clear error of law. It will have an enormous adverse impact on companies which innovate, develop, and market chemical inventions, and consequently on those who would use and benefit from such inventions. The impact of this decision extends far beyond the parties to this case. Patent owners in this field now hold patents that were drafted, prosecuted and issued in full conformity with then-accepted procedure and chemical reality but now may not be enforceable against unlicensed use, even though the unlicensed users reap significant benefits, both economically and business-wise. At a minimum, if this decision stands, copyists who imitate, not innovate, have a ready opportunity to dispute coverage of even the most important chemical patent.

This uncertainty and disincentive to innovation arises from a plain error in patent claim construction. This clear error of law can be corrected only by this Court.

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